

REMARKS

The Examiner has rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by Ham et al. U.S. Patent No. 5,456,667. Applicants respectfully traverse. The Ham et al. patent was first cited against claim 1 under § 103 in combination with the Reger et al. patent in the Office Action of April 6, 2001. In that Action, the Examiner stated that "Ham fails to disclose the ~~slotted section capturing and retrieving~~ particles." A personal interview was held with Supervisory Patent Examiner Richard Seidel in which Applicants suggested amending the claim to read that the slotted retrieval basket section is capable of expansion and contraction "to surroundingly contact, capture and retrieve" particles to further distinguish over the cited references, and Examiner Seidel observed that "with respect to Ham, the device was scemingly not capable of this function due to core member 32." Following that personal interview, Applicants submitted a response in which the claim was amended to add the "surroundingly contact" language. As stated in our response of October 2, 2001, "the structure disclosed in Ham et al. is not capable of surroundingly contacting, capturing and retrieving a particle. The structure includes a catheter body (11) in which the expandable region is formed between the proximal and distal ends (14) and (15). Distal end (15) is bonded to distal collar (31), to which control wire (13) is also affixed. Control wire (13) extends through the interior of expandable region (12), and operates to expand and contract region (12). Also extending through the interior of expandable region (12) are tubular element (29) and core member (32). Due to these elements extending within the interior of the expandable region (12), the slotted section is not capable of surroundingly contacting a particle within the interior. Furthermore, the structure cannot be modified to eliminate these interior elements without rendering the device unsuitable for its

intended purpose." Following Applicants' response of October 2, 2001, the Examiner issued an Action on February 27, 2002 removing the obviousness rejection over Ham et al. in view of Reger et al., and citing a new rejection as a non-final rejection. Thus, Applicants' arguments were sufficient to overcome the rejection of obviousness over the Ham et al. patent in view of the Reger et al. patent. Despite this prosecution history, in which the Examiner admitted on the record that the Ham et al. patent does not disclose each and every element of claim 1, and in which the Examiner withdrew an obviousness rejection over the Ham et al. reference in response to Applicants' arguments, the Examiner now issues an anticipation rejection under § 102(e) over the very same reference that was previously admitted not to teach each and every element of the claim. Because claim 1 recites that "the slotted retrieval basket section is capable of expansion and contraction to surrounding contact, capture and retrieve at least one particle" and the cited reference is not capable of surroundingly contacting, capturing and retrieving at least one particle, the rejection under § 102(e) is improper, and Applicants respectfully request that the rejection be withdrawn.

A Notice of Allowance as to both claims 1 and 7 is believed to be in order, and is respectfully requested. If the Examiner believes any detailed language of the claims requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicants are of the opinion that no additional fee is due as a result of this response. If any charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: Kristi L. Davidson
Kristi L. Davidson
Reg. No. 44,643

2700 Carew Tower
441 Vinc Street
Cincinnati, OH 45202
(513) 241-2324 (voice)
(513) 421-7269 (facsimile)
K:\STSC\10response to 120302 OA.wpd